

REMARKS

Summary of Office Action

Claims 1-58 are pending in this application.

Claims 20, 39, 42, 50-53 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 13-17 and 28 of Alexander et al. U.S. Patent No. 6,177,931 (hereinafter "Alexander").

Claims 1-19, 29, 30, and 57 are rejected under 35 U.S.C. § 102(e) as being anticipated by Klosterman et al. U.S. Patent No. 5,940,073 (hereinafter "Klosterman").

Claims 20-28, 31-56, and 58 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schein et al. U.S. Patent Application Pub. 2003/0005445 (hereinafter "Schein").

Summary of Applicants' Reply

Applicants have amended independent claims 1 and 57 to more particularly define the invention. No new matter has been added, and the amendments are fully supported by applicants' specification.

The rejection of applicants' claims under 35 U.S.C. § 102(e) is respectfully traversed.

The Nonstatutory Double Patenting Rejection

The Examiner has rejected claims 20, 39, 42, 50-53 under the doctrine of obviousness-type double patenting as

being unpatentable over claims 13-17 and 28 of Alexander.

Applicants respectfully request that the Examiner maintain the double patenting rejection so long as any pending claims in the present application are not patentably distinct from one or more claims in Alexander. Applicants will file a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b, c) when the application is otherwise in condition for allowance.

The Rejection of Independent Claims 1 and 57

The Office Action contends that Klosterman shows every feature of applicants' independent claims 1 and 57. (See Office Action, pages 3 and 8). Applicants respectfully disagree.

Applicants independent claims 1 and 57, as amended, are generally directed toward a method and computer readable medium for displaying an advertisement in an electronic program guide (EPG). Television schedule information is stored in a database. Advertisement information is received, and a portion of the received advertisement information is combined with a portion of the stored television schedule information to form a modified advertisement. The modified advertisement is then displayed in the EPG on a screen.

Klosterman describes, *inter alia*, an enhanced program schedule guide with information regions for displaying additional information, such as "advertising and promotional

messages for products or programs." (Klosterman, col. 1, line 64 - col. 2, line 2). In some embodiments of Klosterman, the program guide and information regions may also include other information, such as news, sports, and weather. (See Klosterman, col. 2, line 17-21).

Although Klosterman's information regions may include advertising information and other information, applicants' independent claims 1 and 57 patentably improve upon the teachings of Klosterman by "combining a portion of the received advertising information with a portion of the stored television schedule information to form a modified advertisement." This modified advertisement is then displayed in the EPG on a screen.

Applicants' claimed invention may provide the advantage of allowing an advertiser or service provider to transmit a single (e.g., generic) advertisement to multiple users and then combining the advertisement with stored television schedule information to create a modified advertisement. (See applicants' Abstract). This enhanced advertisement may then be displayed to the user to customize the user's advertisement viewing experience.

Accordingly, applicants submit that Klosterman fails to show or suggest every claimed feature of applicants' independent claims 1 and 57. Applicants respectfully request,

therefore, that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

The Rejection of Independent Claims 20, 39, and 58

Applicants' independent claims 20, 39, and 58 are generally directed toward a method for modifying an advertisement in an EPG. Television schedule information is stored in a first database. Advertisement information is stored in a second database. A portion of the advertisement information is incorporated into (claims 20 and 58) or combined with (claim 39) a portion of the advertisement information to form a modified (claims 20 and 58) or updated (claim 39) advertisement. The modified or updated advertisement is then displayed on a screen or in the EPG.

Schein refers to systems and methods for "directly linking television viewers with . . . advertisers." (See Schein, ¶ 7). The Office Action contends that Schein shows a "database structured internally as schedule data structures . . . linked by handles." (Office Action, page 8). The Office Action also contends that Schein further shows an "advertisement database . . . including advertising text and logos including IDs for linking the advertisement to [shows] displayed in the EPG." Id.

While Schein shows directly linking viewers with advertisers, applicants respectfully submit that applicants'

claimed invention patentably improves upon the teachings of Schein. As described above, applicants' claimed invention forms a modified or updated advertisement by combining or incorporating stored program schedule information with advertisement information. For example, a generic advertisement for a particular television show may be customized by including the local television channel(s) and time(s) the show is to be broadcast to the user. In this way, the user is presented with an enhanced advertisement including television schedule information. (See, e.g., applicants' specification, ¶¶ 321 - 331).

Accordingly, applicants submit that Schein fails to show or suggest every claimed feature of applicants' independent claims 20, 39, and 58. Applicants respectfully request, therefore, that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

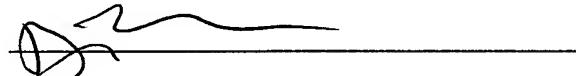
Dependent Claims 2-19, 21-38, and 40-56

Claims 2-19, 21-38, and 40-56 depend from independent claims 1, 20, and 39, respectively. Applicants submit that these claims are allowable over the prior art of record for at least the same reasons as their respective independent claims. Applicants respectfully request, therefore, that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

Conclusion

For the foregoing reasons, applicants submit that claims 1-58 are allowable over the prior art of record. This application is therefore in condition for allowance. Accordingly, prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,



Brian E. Mack
Registration No. 57,189
Agent for Applicants

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
(212) 596-9000